Hovsepian v. Apple, Inc. Doc. 255

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**UNITED STATES DISTRICT COURT**

**FOR THE NORTHERN DISTRICT OF CALIFORNIA**

**SAN JOSE DIVISION**

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| In re<br><br>ACACIA MEDIA TECHNOLOGIES CORPORATION | Case No. 05 CV 01114 JW<br><br>**SUPPLEMENTAL DECLARATION OF ALAN P. BLOCK REGARDING PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S COMBINED REPLY TO MOTION FOR RECONSIDERATION OF CERTAIN CLAIM CONSTRUCTION TERMS CONSTRUED BY THE COURT IN ITS THIRD CLAIM CONSTRUCTION ORDER AND ITS FOURTH CLAIM CONSTRUCTION ORDER**<br><br>DATE: August 17, 2007<br>TIME: 9:00 a.m.<br>CTRM: Hon. James Ware |

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I, Alan P. Block, hereby declare as follows:

1. I am a member of the law firm of Hennigan, Bennett & Dorman LLP, counsel of record for plaintiff Acacia Media Technologies Corporation in this case. I have personal knowledge of the facts stated herein and, if called as a witness, I could and would testify competently thereto.

2. A true and correct copy of selected portions from Round 1 Defendants' Responsive Claim Construction Brief Regarding United States Patent No. 6,144,702, May 13, 2004 are attached hereto as Exhibit 4.

3. A true and correct copy of selected portions from Round 1 Defendants' Claim Construction Brief, January 8, 2004 are attached hereto as Exhibit 5.

4. A true and correct copy of selected portions from Round 1 Defendants' Opposition Claim Construction Brief, January 22, 2004 are attached hereto as Exhibit 6.

5. A true and correct copy of a selected portion of *Farber, Landis on Mechanics of Claim Drafting, Sec. 4.2 (5th Ed. 2006)* is attached hereto as Exhibit 7.

I declare under penalty of perjury under the laws of the United States that the following is true and correct.

Executed this 3rd day of August, 2007, at Los Angeles, California.

/s/ Alan P. Block
Alan P. Block

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# EXHIBIT 4

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

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| ACACIA MEDIA TECHNOLOGIES CORPORATION,<br><br>Plaintiff,<br><br>v.<br><br>NEW DESTINY INTERNET GROUP, ET AL.,<br><br>Defendants. | Case No. SA CV 02-1040 JW (MLGx)<br><br>**Consolidated Cases:**<br>SA CV 02-1165-JW (MLGx)<br>SA CV 03-0218-JW (MLGx)<br>SA CV 02-1048-JW (MLGx)<br>SA CV 03-0219-JW (MLGx)<br>SA CV 03-0308-JW (MLGx)<br>SA CV 03-0271-JW (MLGx)<br>SA CV 03-0259-JW (MLGx)<br>SA CV 02-1063-JW (MLGx)<br><br>**Related Cases:**<br>SA CV 03-1801 JW (MLGx)<br>SA CV 03-1803 JW (MLGx)<br>SA CV 03-1804 JW (MLGx)<br>SA CV 03-1807 JW (MLGx) |
| AND REFERENCED CONSOLIDATED AND RELATED CASES | **DEFENDANTS' RESPONSIVE CLAIM CONSTRUCTION BRIEF REGARDING UNITED STATES PATENT NO. 6,144,702**<br><br>Date: May 18-20, 2004<br>Time: 9:30 a.m.<br>Ctrm: 9C |

> means places the formatted data into a sequence of addressable data blocks. We believe that part of the objection arose from the fact that the claims specified "ordering means" which was erroneously labeled "(114)". This is incorrect – the ordering means may simply include, in the preferred form, the time encoding (114).

(Miller Decl., Ex. OO at 136.)

We urge the Court not to let Acacia dispense with these and other statements made by the inventors in favor of its result-driven approach devised a decade after the fact. Defendants respectfully request that the Court construe the claims consistent with the intrinsic evidence as set forth herein.

## II. ARGUMENT

### A. "a transmission system at a first location in data communication with a reception system at a second location"

#### 1. The Court Should Apply the Agreed-Upon Definition of "transmission system" and "reception system" and Should Not Redefine the Terms to Include People.

As set forth in Defendants' opening brief, the construction of "transmission system" is simple and straightforward. The IEEE dictionary defines "transmission system" as "an assembly of elements capable of functioning together to transmit signal waves." (Ex. NN at 575.) This definition is consistent with the term's use in the claims, written description, and prosecution history of the '702 patent. Accordingly, "transmission system" may be given the common dictionary meaning. *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091 (Fed. Cir. 2003).

Acacia does not dispute the propriety of the agreed-upon IEEE definition, as it was also used by Acacia to form its proposed construction. (*See* Pl.'s Br. at 14.) Rather, Acacia newly contends that the Court must further define the term "elements" employed in the IEEE definition of "transmission system" to include "people, machines, and methods," through the use of a separate cherry-picked definition of the word "system" (divorced from the phrase "transmission system").[1] (*Id.*) The Court should reject this approach.

At the outset, there is no need for the Court to define the term "elements" within the agreed-upon definition of the phrase "transmission system"—the claims of the '702 patent all provide elements of the claimed transmission system. Each of the '702 patent claims recite the phrase "wherein said transmission system comprises" and proceed to list the claimed elements of the transmission system. Accordingly, the Court need not define the "assembly of elements" in the IEEE definition—the claims already do it.

But this entirely proper approach does not suit Acacia's needs because this construction of "transmission system" does not include humans, which Acacia needs to get into the claims, not for the '702 patent, but for the '992 patent. Put simply, the construction offered by Acacia is a back-door effort to convince the Court to put human beings into the claims of the '992 patent. As part and parcel of this effort, Acacia devises a theory to incorporate a definition for "system" into the construction of 'transmission system" so that the latter may include humans. This theory, to the extent it can be understood, goes something like this:

- In the IEEE dictionary, the term "system" has 19 different definitions relating to various fields in the electronic arts. One of these definitions—the tenth definition relating to software—includes an unexplained reference to humans. It provides: "a collection of people, machines, and methods organized to accomplish a set of specific functions." (Block Decl. Ex. 11 at 1329.)

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[1] Acacia's construction is plainly an attempt to support its infringement theory under the '992 patent, which is dependent on human beings providing corresponding "structure" to "means" limitations in claim 1 and performing certain steps of method claims (claim 41) that the claims expressly state must be performed by a "transmission system." Even putting aside the legal impropriety of these arguments, addressed in detail in Defendants' previous briefs and argument, the patentees disclaimed "manual" transmission systems—to the extent such a thing even exists—in their arguments over the Fenwick reference. (*See* Ex. B at 159.)

- The IEEE definition of "transmission system" requires that a transmission system include a number of "elements."
- "Elements" are "machines and methods." (Pl.'s Br. at 14.)
- Because the patent specification states that a system operator interacts with the system to perform certain processes, the "elements" of the transmission system must include a person, as opposed to simply operating the way the patent states—via, in part, human interaction—which is no different than the way most apparatuses or systems operate. *Compare Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1270 (Fed. Cir. 1999) (noting that a mechanical switch would necessarily require a human operator).
- Accordingly, the term "elements" in the IEEE definition of "transmission system" must be "further defined by the definition of 'system,' which elaborates on the meaning of elements to include 'people, machines, and methods.'" (Pl.'s Br. at 14-15.)

This approach to claim construction—devising a construction to suit an infringement theory, cherry-picking definitions, and crafting ambiguity where it does not exist—is manifestly improper and demonstrates again the result-oriented approach to claim construction proffered by plaintiff.

Indeed, we note that this approach is driven solely by Acacia's wish to have human beings be a part of the claimed transmission system, and not by any genuine ambiguity in the claims. But, to date, Acacia has not been able to cite a single case where a human was construed to be a structure. Beyond the myriad of other reasons cited by defendants, the reason for its failure is further evident from 35 U.S.C. § 101, which defines a patentable subject matter. Section 101 provides:

Whoeover invents or discovers any new or useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

The transmission systems of the '992 and '702 patents are clearly not directed to compositions of matter or to a process (method). Consequently, the claims must fall under the category of a "machine" or "manufacture" to be patentable. Not even Acacia would dispute the fact that human beings are not machines or items of manufacture.

For these reasons, the terms "transmission system" and "reception system" should not be construed to include human beings as structure. The Court should construe "transmission system" to mean an assembly of elements that function together to transmit electrical signals, and should construe "reception system" to mean an assembly of elements that function together to receive electrical signals from the transmission system.

**2. The Claims are Clear that the Transmission System Is Located "at a first location," the Reception System Is Located "at a second location," and They Are Not At Multiple Locations.**

Every claim of the '702 patent recites a "transmission system at a first location in data communication with a reception system at a second location." The parties agree that this limitation requires the location of the transmission system be different from the location of the reception system. The dispute centers around where the transmission and reception systems are located. Acacia wrongly contends that the transmission system, and presumably the reception system, "may be located in one facility or spread over a number of facilities." (Pl.'s Br. at 15.) Acacia's construction ignores the clear language of the claims and the inventors' express definition of the term "location."

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UNITED STATES DISTRICT COURT

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| ACACIA MEDIA TECHNOLOGIES CORPORATION,<br>Plaintiff,<br>v.<br>NEW DESTINY INTERNET GROUP, ET AL.,<br>Defendants. | Case No. SA CV-02-1040 JW (MLGx)<br><br>**CLAIM CONSTRUCTION BRIEF OF AEBN, INC.; ADEMIA MULTIMEDIA, LLC.; AUDIO COMMUNICATIONS, INC.; CYBERHEAT, INC.; GAME LINK, INC.; INNOVATIVE IDEAS INTERNATIONAL; LIGHTSPEED MEDIA GROUP, INC.; NEW DESTINY INTERNET GROUP, LLC; VS MEDIA, INC.** |
| AND ALL RELATED CASE ACTIONS. | |
| | Date: February 6, 2004<br>Time: 10:00 a.m.<br>Ctrm: |

tapes, computer disks, documents of various sorts, musical instruments, and other physical objects." (*Id.* at 6:10-15.) Accordingly, the "library means" element of claim 1 requires that the claimed transmission system have a "source material library"—the original source items available in the transmission system organized in a library.

### 2. "Storing Items Having Information in a Source Material Library": This Claim Step Should be Interpreted to Mean that the Transmission System Has Readily Accessible for Use Original Source Items of the Transmission System in a Library.

Claim 41 requires the step of "storing items having information in a source material library." Each of the steps of the method of claim 41 are required by the preamble to be explicitly "performed by [the] transmission system," a limitation added to the claim by amendment near the end of the prosecution. (Ex. B at 231.)

As with the corresponding apparatus of claim 1, "storing" in the context of claim 41 means to place or leave in a location for later use. (Ex. Q at 545.) Here, it is the items having information that are stored, and they are stored in a source material library. And this source material library must be part of the transmission system.

The source material library, as demonstrated above, is the organized collection of original source materials that the transmission systems converts, compresses, and then transmits. As its name implies and as the written description makes clear, it is not simply an off-site library, such as a public library or a video store that bears no relation to the transmission system. Rather, it is the library of original source materials that is available for use by the transmission system, as needed. By necessity, it contains the original source material of the items that have been converted and compressed into the compressed data library, and may contain other materials that might be used by the transmission system at another time, if requested by a user. Accordingly, "storing items having information in a source material library" should be interpreted to mean that the transmission system has readily accessible for use original source items of the transmission system in a library.

### C. The "Identification Encoding Means" Limitation Lacks Corresponding Structure and Is Invalid Under §112, ¶ 2.

As part of the transmission system of claim 1 of the '992 patent, the applicants included a structure they identified as an "identification encoding means for retrieving the information in the items from the library means and for assigning a unique identification code to the retrieved information." This claim element necessarily appears in dependent claims 2 through 18, many of which have been asserted by Acacia.

The parties agree that the "identification encoding means" limitation is written in "means-plus-function" format and is subject to 35 U.S.C. §112, ¶ 6. The parties also agree the claimed functions are: (1) retrieving the information in the items from the library means and (2) assigning a unique identification code to the retrieved information. The only item thus remaining for construction is the structure that corresponds to these functions. Defendants contend that there is none.

As is undisputed, the "identification encoding means" of claim 1 of the '992 patent performs two functions. First, it retrieves the information in the items from the library means. As described previously, the "library means" may include a number of items, such as books, video tapes, compact discs, etc. Notably, the identification encoding means does not retrieve the items themselves, but rather retrieves the information from the item. In the example of a videotape, the identification encoding means would not physically retrieve the videotape from the library means, but would retrieve the information stored on the videotape.

After retrieving the information, the identification encoding means then assigns a "unique identification code" to the retrieved information. Defendants proposed construction of unique identification code is set forth later in this brief.

The only "structures" disclosed by the '992 patent specification for performing these functions are something called an "identification encoder 112" and a

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recite the same act—storing items. Accordingly, the term "storing" should be given the same meaning in claims 1 and 41. *Inverness Med.*, 309 F.3d at 1371; *Southwall Techs.*, 54 F.3d at 1579.

As it does with "remote locations," Acacia wrongly proffers two differing constructions for the word "storing" in these claims. (Acacia Br. at 19, 22.) The only explanation given for this difference is that the "storing" limitation of claim 41 "is being used to describe a definite action—the act of 'storing.'" (*Id.* at 22.) This distinction is nonsensical. The purpose of the "storing" language in claim 1 is to describe the function performed by the means, which in this case is the "library means." This is no different than the step listed in claim 41.

For the term "storing" in claim 41, Acacia presents the dictionary definition: "to place or leave in a location (as a warehouse, library, or computer memory) for preservation or later use or disposal" (Acacia Br. at 22), a definition similar to that proposed by defendants for both Claims 1 and 41, and which is the same as that relied on by Acacia in discovery for both claims. (Ex. X at 14-15, 17, 21-22, 24, 28-29, 31.) When viewed in the context of the claims and the patent's written description—not to mention the fact that the definition rejected by Acacia for claim 1 mentions a library—this essentially agreed-upon definition makes sense. The purpose of the source material library of claim 41 and the library means of claim 1 is to store items for "later use" by the transmission system. ('992 patent at 18:1-3, 20:17-21.) For the items to be of later use, they must be readily accessible to the transmission system as needed. Indeed, this capability is explicitly required by claim 1, which requires an "identification encoding means for retrieving the information in the items from the library means." (emphasis added.)

Accordingly, the claim term "storing" in claims 1 and 41 should be construed to mean "to place or leave in a location for later use."

# EXHIBIT 7

LEXSTAT LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING § 4:2

LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING -- FIFTH EDITION
*** Current through Release No. 4 ( November 2006 ) ***
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Robert C. Faber

CHAPTER 4. METHOD OR PROCESS CLAIMS

Landis on Mechanics of Patent Claim Drafting § 4:2

§ 4:2 Elements of Method Claims

Generally, the verbs in a method claim need not be phrased in any particular voice or tense as long as there is no ambiguity and the requirements of section 112 are met. [n9] Nevertheless, it must be remembered that the elements of a method claim are method *steps,* which should usually be verbal (gerundial) phrases, introduced by a gerund or verbal noun (the "-ing" form of a verb), such as (the gerunds are italicized):

(a) *reciprocating* the guide . . .

(b) *punching* a series of holes . . .

(c) *impressing* a signal . . .

(d) *coating* the sheet with an adhesive . . .

(e) *heating* the mixture to a temperature of . . .

(f) *separating* the alcohol from the aqueous solution . . .

(g) *distilling* the aqueous solution to separate the alcohol therefrom . . .

(h) *fractionally crystallizing* the aqueous solution to separate the alcohol therefrom . . .

(i) *permitting* the mixture to cool . . .

The three steps ("separating," on the one hand, and "distilling" or "crystallizing," on the other) illustrate, respectively, generic and two species method steps (see section 6:9).

One should be aware that as to the format of step (g), examiners sometimes express a preference for language similar to the following: (g') *separating* the alcohol from the aqueous solution *by distilling* the solution. . . ." The argument favoring such wording is along these lines: "Regarding the phrase 'distilling . . . to separate,' [as in step (g)] one *could* distill the solution, yet never achieve alcohol separation. Such separation being the ultimate goal of the step, it (separation) should be *more positively recited* by being made the introductory gerund of the clause ["separating . . . by distilling," as in step (g')] which sets forth the step."

It is believed that this is fallacious reasoning. First, steps (g) and (g') may be seen to cover exactly the same territory logically and semantically. Second, an objection to the *form* of a step written as step (g) ignores the expressly stated *substantive* limitation therein of "distilling . . . *to* separate." This limitation *requires* that the distillation effect the separation. Third, an administrative preference for one or the other form of the step ignores the reasonable latitude permitted by decisions such as *Lewin,* [n10] cited at the beginning of this section. Fourth, seemingly ignored are the principles set forth in the next paragraph. [n11]

The choice of which word (gerund) to use for introducing a method step is similar to the choice of which word to use for describing elements in apparatus claims. Generally, one chooses the broadest word the prior art will allow. Thus, in step (g), "distilling" is narrower than step (f) "separating." One may recite a generic or broad step, such as "separating," that is really a function or result of a more specific act such as "distilling" or "crystallizing." Moreover, it is permissible for a method step to recite some condition or property without reciting in the claim every step necessary to obtain or achieve that condition or property. [n12] For example, "distilling" alone in step (g) should be sufficient. There should usually be no need, in place of "distilling," to recite "*placing*" the aqueous solution in a (certain) container . . ."; "*heating* the solution to a (certain) temperature . . ."; "*condensing* the alcohol vapors . . ."; etc. Of course, the terms used must find some antecedent in the disclosure. Preferably, therefore, the word appearing in the claim can be found in the specification, where it will have also been defined or explained or how it relates to the subject of the invention will have been described. Often, the word used is itself so clear in its meaning, like "heating" or "separating," that explanation of the word is not needed and its simple or mere mention by use of the precisely same word or a clearly equivalent word in the supporting specification is a sufficient antecedent. However, where the step or process procedure is not clear from the word used (for example, distilling in a particular context, like wine or petroleum, needs more explanation), the mere word "distilling" is not detailed enough, and its component parts, heating and separating, may also have to be recited.

Pragmatically, the choice of what gerund to use is really of little moment as to the form of the claim. Moreover, 35 U.S.C. § 112 states (in the same paragraph sanctioning "means plus function" clauses) that:

> An element in a claim for a [method] combination may be expressed as a . . . step for performing a specified function without the recital of . . . acts in support thereof, and such claim shall be construed to cover the corresponding . . . acts described in the specification and equivalents thereof.

Thus, the statute expressly sanctions the use of broad functional steps, such as "separating," where the prior art permits, rather than the specific *act*, "distilling." The interpretation of this language is similar to that described under "means claims" in section 3:25: the claim "*shall* be construed to cover the corresponding . . . acts described . . . and equivalents. . . ." Consequently, as with means clauses, the scope of protection afforded is exactly as broad as "the invention" disclosed in the specification, plus equivalents. Although "step of" clauses may be used whenever the prior art permits, their scope may be more restricted under applicable precedent than a clause with more specific language on the method step. For example, in (f) or (g) above, one could recite "the step of separating" or "performing a step separating" or other equivalent language which could be governed by section 112. Better now would be to use the actual recital of a process step, "separating" or perhaps "distilling to separate" or "distilling for separating." The latter two phrases would now likely be governed by section 112, and might be restricted merely to the steps disclosed in the specification and their equivalents (see section 3:25).

The distinction between acts and steps is probably more academic than real, as very few, if any, cases focus on the difference in concept between a functional step and the act done to perform the step. As with "means claims," such functional step clauses must be limited to claims to *combinations*. In concept, a single-step method claim is all right (see section 4:1) only when the step is an act.

The preamble of a method claim may be almost the same as that of a mechanical claim. Generically, the following preamble format is usually appropriate: "A *method of* (or process for) performing a specified act (or operation) on a particular article (or workpiece or chemical substance) which comprises: . . ." Except for the words "a method" this format is identical to the format proposed in section 3:2 for apparatus claim preambles. Note that the workpiece is properly placed in the preamble, just as it is in the apparatus claims (see section 3:3). In the broader claims, avoid describing the workpiece or article any more narrowly than the prior art requires, which would be an "unnecessary article limitation" in the words of the Patent and Trademark Office comments on grading Agent's Exam method claims. The preamble is not locked into a particular format, and can be shorter than the above suggestion, as the invention warrants.

Another similar preamble format ends with the transition words "which comprises *the steps of:* . . ." The choice between these and equivalent forms is a matter of style. Equivalents of "comprises" are used: "includes," "has." The words "the steps of" or equivalents might not be used (see Example III in chapter 3).

Referring again to the take-up barrel of Example III (see section 3:25.1, above) a method claim relating thereto might read:

4. A method of collecting an advancing strand in a barrel, which comprises:

(a) *guiding* the advancing strand into the barrel;

(b) *rotating* the barrel so that the point of collection of the strand varies circularly with respect to the bottom of the barrel; and

(c) *reciprocating* a guide point above the barrel so that the point of collection varies radially with respect to the bottom of the barrel.

Note the similarity in form to the apparatus claim in section 3:25. If the title of Claim 4 were changed to "Apparatus for . . ." and the phrase "means for" were inserted before each step, one would have a proper apparatus claim (at least as to form). This is typical of most method claims: Add the words "means for" to transform a method step into an apparatus element. Similarly, where an apparatus element is expressed in "means for" fashion, deletion of that phrase usually results in a proper (as to form) method step. Thus, method and apparatus claims can be of comparable scope and equally broad or narrow. Where the practitioner elects to include both apparatus and method claims in a specification, it would not be unusual to have at least some of the two types of claims analogous, that is, the method steps in a method claim become "means for" clauses in the analogous apparatus claim. As is elsewhere recommended, where an invention permits, different classes of claims should be used to cover an invention. Where an apparatus accomplishes something in a series of operations, the series can be claimed in a series of steps in a method claim.

Further examples of method claims of many kinds are given in appendix A.

Summary

The elements of a method claim are acts or steps, customarily phrased as gerunds ("heating"). They can be broad or narrow, depending on the prior art, and functional step clauses ("separating") can be used, corresponding to means clauses where the function performed, not the act used to do it, is the important thing. Single step method claims are permitted where the step is an act, not a functional step.

**FOOTNOTES:**

[n9]Footnote 9. *Ex parte* Lewin, 154 U.S.P.Q. (BNA) 487 (Board of Patent Appeals and Interferences 1966).

[n10]Footnote 10. *Id.*

[n11]Footnote 11. If the two formats, (g) and (g'), however, truly *are* the same, one would usually be foolish to "fight" the examiner on the point. There are usually more important issues present, and a firm stand by the applicant on one particular format may not, in the words of Cicero, "render the audience [here, the examiner] benevolent" as to more substantive issues.

[n12]Footnote 12. *In re* Roberts & Burch, 176 U.S.P.Q. (BNA) 313 (C.C.P.A. 1973); *In re* Alul & McEwan, 175 U.S.P.Q. (BNA) 700 (C.C.P.A. 1972); *In re* Rainer, 134 U.S.P.Q. (BNA) 343 (C.C.P.A. 1962). Of course, either the specification must disclose, or a person skilled in the art must know, how to achieve the condition or property.